REMARKS

Claims 1-74 are pending in the above-identified application and have been subjected to restriction by the Office Action under 35 U.S.C. §121 as follows:

I. Claims 63-72, drawn to crystalline L-arabinose, classified in class 536, subclass various

II. Claims 73 and 74, drawn to use of the product of Group I in pharmaceuticals and foodstuffs, classified in classes 514 and 536, subclass various

III. Claims 1-62, drawn to a process for preparation of the product of Group I (arabinose), classified in class 536, subclass various.

In support of the present Restriction Requirement, the Office Action has alleged that Groups I, II and III are distinct from one another.

As indicated hereinabove and in order to be fully responsive to the requirement for restriction imposed by the Office Action, applicants provisionally elect, with traverse, to prosecute the subject matter of Group III, i.e., Claims1-62.

In addition, applicants reserve the right to file a divisional application directed to the non-elected subject matter.

Notwithstanding the foregoing, applicants hereby traverse, pursuant to 37 C.F.R. §§1.111 and 1.143, the requirement for a restriction and request reconsideration thereof in view of the following remarks.

Applicants respectfully request that the Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141 and 1.142.

35 U.S.C. §121 provides that the Commissioner may restrict an application when two or more **independent and distinct** inventions are claimed in a single application (emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction on condition that independent **and** distinct inventions are found within one application. Only the statutory requirement that the various groups of claims are "distinct" has been preferred as a basis for requiring the restriction. Even assuming, pro arguendo, that the Office Action was correct with respect to distinctiveness, there is absolutely no indication in the Office Action that Groups I-III are also independent, except a blanket statement found towards the bottom of page 3 of the restriction requirement where the Examiner stated that "[I]t is noted that examination of the three independent and distinct inventions would indeed impose an undue burden upon the examiner in charge of this application.". In fact, applicants submit that there is an interdependence between each of the groups alleged to be patentably distinct.

MPEP §802.01 defines independent as follows:

> The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is they are unconnected in design, operation or effect...

Applicants respectfully submit that the subject matter in Groups I, II and II are all related in such a way that they are not "independent" for purposes of establishing a restriction requirement. More specifically, all Groups are connected in design, operation or effect and are thus not "independent".

The subject matter of Group I is directed to a crystalline L- arabinose "which is obtainable by a process as claimed in any one of claims 1 to 62" (see claim 63), while the subject matter of Group II is directed to the use of the L-arabinose as claimed in any one of the claims of Group I in pharmaceuticals and foodstuffs, and the subject matter of Group III is directed to a process of recovering arabinose. Thus, Groups I and II are related and are not independent. They therefore have a disclosed relationship, i.e. Group II relates to the use of the product claimed in Group I. The Examiner in fact acknowledges the relationship in setting forth the restriction wherein it is stated that the Group II claims are "drawn to use of the product of Group I. Even further, the Group II claims as written are dependent upon the Group I claims (see claim 73: "Use of the crystalline L-arabinose **of any one of claims 64 to 72**..." (emphasis added).

The same can be said of Groups I and III. As noted by the Examiner, Group III is "drawn to a process for preparation of the product of Group I". Thus, there is a clear and real relationship between the claimed subject matter of Groups I and III as well. The Examiner's attention is directed to claim 63 wherein it is claimed that the compound is one "which is obtainable by a process as claimed in any one of claims 1 to 62". Thus again, a clear and real relationship exists between the two groups of claims.

Finally, Groups II and III are clearly related and dependent upon one another as the process for preparation of the Group I compounds, i.e. the subject matter of Group III, produces the products which are being claimed for specific uses in the Group II claims. Consequently, because these groups of claims are connected in design, operation and/or effect and are therefore not independent, the claims which the Office Action has grouped separately

are not "independent and distinct" so as to justify the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

Again, the claims of Group I are directed to a product which are produced by a process within the scope of claims 1-62 (assigned to Group III). Those product claims cannot be considered "independent" of claims 1-62 drawn to the process of preparing the product. Thus, the claims of Group I are very clearly interrelated and interdependent upon the claims of Group III, not "independent and distinct" as required in a restriction requirement. Similarly, the claims of Group II are directed to the use of the product assigned to Group I as produced by the process assigned to Group III.

The interdependence of the composition of matter useful for pharmaceuticals and foodstuffs and the process for preparing the composition of matter is confirmed – indeed, it is mandated – by virtue of the fact that the description requirements of 35 U.S.C. §112 compel disclosure of all three aspects of the invention in the one application which applicants have filed. That is, pursuant to 35 U.S.C. §112, an application claiming a crystalline L-arabinose compound is required to disclose inter alia how to make and use the invention: in other words, the description of a process for preparing the claimed product is a mandatory part of the application directed to the product itself and the use thereof. Likewise, an application claiming a process for preparing a compound is required to disclose inter alia the compound produced by the process and its use. Indeed, if any of these aspects of a complete disclosure were omitted – perhaps by an applicant relying on what the Patent and Trademark Office considers "independent and distinct" – the application could be considered defective under §112, first paragraph.

Consequently, it is clear that aspects of of a given invention, such as product, use of said product and the process of making that product, are necessarily interdependent, not independent, from each other.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein, so as to encourage applicants to provide a more detailed disclosure of all aspects of their invention. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner recognized by 35 U.S.C. §112, all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), the applicants are required to either conduct simultaneous prosecution with attendant filing fees and costs or face a compromise of the term of their patent assets.

It is vital is filed to all applicants that Restriction Requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double-patenting. The third sentence of U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention-double-patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicant respectfully urges the Examiner not to require restriction in cases such as the present application.

The Office Action also seems to suggest that a prior art search requiring search in more than one classification is sufficient criteria for maintaining a restriction to allegedly different patentable inventions. This, of course is error. It simply does not comply with the provisions under 35 U.S.C. §121. (See In re Kuehl, supra).

The classification system is an unreliable basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent an Examiner from basing patentability decisions, as to claims he assigned to one group, on patent references found in the subclass(es) with which he associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

Hence, it is respectfully requested that the United States Patent and Trademark Office reconsider and withdraw the requirement for restriction pursuant to 35 U.S.C. §121 and provide an action on the merits with respect to all of the claimed subject matter.

Respectfully submitted,

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